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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,246	06/28/2000	David L. Patton	81219F-P	5703

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/605,246

Applicant(s)

PATTON ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22, 28-30 and 36 is/are pending in the application.
- 4a) Of the above claim(s) 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Note: Claim 36 remains pending in the present application. In the Election/Restriction mailed December 5, 2000, claim 36 was inadvertently omitted from Group III. Since Group III (claims 31-35) was not elected and cancelled in Paper No. 4, claim 36 should also be cancelled.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 2, 7, 8, 13, 14 and 28 are rejected under 35 U.S.C. 102(a) as being anticipated by Masato et al. (JP 2000-112356).

Masato et al. disclose an official postal product comprising a printing substrate (1); a first image area having an official postal indicia (11,12); a second image area having a personal image (13- design region); and a protective coating on the personal image in the second image area such that an official cancellation mark placed over the second area will not permanently adhere to the personal image (see Advantage section of English translation – “Prevents marking on photograph during postmarking due to divided area for photograph and area for postmarking”). Inherently, the photograph contains some type of coating that prevents permanent adherence of ink.

Regarding claims 2, 8 and 14, Masato et al. disclose the postal product being a postal stamp.

Regarding claims 7, 13 and 28, see above rejections with respect to claim 1. It should be noted that in claims 7 and 13, a separate label has not been positively claimed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-6, 9-12, 15-21, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masato et al.

Masato et al. disclose the claimed invention except for the particular material as claimed for the protective coating (claims 3, 4, 9, 10, 15, 16, 29 and 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide whatever material desired, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416. Furthermore, applicant has failed to disclose that material used for the protective covering is critical to the invention.

Masato et al. disclose the claimed invention except for the postal product being an envelope or a postcard (claims 5, 6, 11, 12, 17 and 18). The Examiner takes Official

Notice that it is well-known in the art that envelopes and postcards are postal products since they require postage for delivery.

Masato et al. disclose the claimed invention except for explicitly setting forth the type of printer used to print the first and second image areas (claims 19-21). It would have been obvious to one having ordinary skill in the art at the time of the invention to use any conventional printer for printing the first and second image areas (i.e. inkjet printer, wax sublimation printer, or electrophotographic printer), since the Examiner takes Official Notice that these different printers and printing methods are conventional in the art and it would have been obvious to choose any of the abovementioned printing methods depending on the end result desired.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abt et al. ('768) in view of Onishi ('649) and Erickson ('443) and further in view of Masato et al., as used above.

Abt et al. disclose a first sheet (16) having a plurality of adhesive-backed, removable shapes such as stamps. The stamps would be considered official postal products. Abt discloses the claimed invention except for a second sheet having a plurality of labels.

Onishi discloses a sheet (12) having a plurality of labels (as seen in figure 12) each having a personal image (as seen in figure 2). Therefore, it would have been

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obvious to one having ordinary skill in the art at the time of the invention to modify Abt's invention to include a second sheet of labels having a personal image, as taught by Onishi, since doing so would provide an additional sheet of adhesive-backed, removable shapes that may be personalized.

Abt et al., as modified by Onishi, disclose the claimed invention except for placing the labels of the second sheet on an area of the official postal product.

Erickson discloses placing a transparent label (1- sheet) which can be placed over a stamp receiving surface (as seen in figure 2). Therefore, it would have been obvious to modify Abt's invention to include the placement of the labels over the official postal product, as taught by Erickson, to provide a protective coating for the postal product.

Abt et al., as modified by Onishi and Erickson, disclose the claimed invention except for the protective coating preventing a cancellation mark from permanently adhering to the personal image.

Masato et al. disclose an official postal product comprising a printing substrate (1); a first image area having an official postal indicia (11,12); a second image area having a personal image (13- design region); and a protective coating on the personal image in the second image area such that an official cancellation mark placed over the second area will not permanently adhere to the personal image (see Advantage section of English translation – "Prevents marking on photograph during postmarking due to

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divided area for photograph and area for postmarking"). Inherently, the photograph contains some type of coating that prevents permanent adherence of ink.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Abt's invention to include a protective coating that prohibits a cancellation mark from adhering to the personal image, as taught by Masato, to provide a layer for the personal image that protects the image from being damaged when the postal product is processed in the mail system.

### ***Response to Arguments***

6. Applicant's arguments filed June 27, 2002 have been fully considered but they are not persuasive.

Applicant argues that Masato et al. fail to disclose a protective coating covering the personal image as claimed. The Examiner disagrees. Masato et al. disclose a substrate having a first image area with an official postage indicia (11, 12) and a second image area having a personal image (13). As seen in figure 3(d), the postmark (14) applied to the stamp does not cover the personal image. The intent of Masato's invention is to prevent any type of markings on the image area. Therefore, it is inherent that a coating is placed on the image area that prevents markings.

Applicant states that paragraph 16 on page 7 states that there are two separate and distinct locations where the image and official postage may be provided and paragraph 18 on page 8 states that the postmark is not provided on the design region 21. The translation provided by applicant is very difficult to comprehend and while the cited passages are consistent with what applicant sets forth, it is not clear whether or not these passages have been taken out of context. Masato et al. disclose that the postmark is not done to design region 21. This could be interpreted to mean that the postmark is not adhered to design region 21 when applied to the stamp (thus, not "done" to design region 21 could be interpreted as not permanently adhered to). The Examiner continues to maintain that as disclosed in the Advantage section of Masato et al., markings are prevented on the photograph during postmarking as presently claimed by applicant.

For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dlugos et al. (6,112,193), Manduley et al. (5,373,115), Hubbard (3,869,986) and <http://www.philatelly.com>.



8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



mc

September 16, 2002



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